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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/441,204	11/16/1999	DAVID VERCHERE	56490.000002	3995

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HUNTON & WILLIAMS  
INTELLECTUAL PROPERTY DEPARTMENT  
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WASHINGTON, DC 20006-1109

EXAMINER

POND, ROBERT M

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 02/10/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

09/441,204

Applicant(s)

VERCHERE, DAVID

Examiner

Robert M. Pond

Art Unit

3625

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 25 November 2002 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
  - (b) ☐ they raise the issue of new matter (see Note below);
  - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
  - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☒ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☐ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_

Claim(s) objected to: \_\_\_\_\_

Claim(s) rejected: \_\_\_\_\_

Claim(s) withdrawn from consideration: \_\_\_\_\_

8. ☐ The proposed drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_
10. ☐ Other: \_\_\_\_\_

  
Jeffrey A. Smith  
Primary Examiner

Continuation of 5. does NOT place the application in condition for allowance because: Affidavit is formally acceptable except for the omission of the US, NAFTA, WTO statement per MPEP 715.07(c).

The affidavit alleges conception date prior to 6/22/99 (effective date of the earliest reference), however, no satisfactory evidence to support this allegation is presented. Although Declarant may rely on complete disclosure to another person to establish conception (*Mergenthaler v. Scudder*, 1897 C.D. 724, 81 O.G. 1417 (D.C. Circuit 1897)), such allegation must be capable of proof. In this case Appendices B and C, collectively do not satisfactorily evidence the fact that conception of the instant invention occurred prior to 6/22/99. For example, each of Appendices B and C merely allege that which already is alleged by the Applicant in Appendix A. None of Appendices A-C, offer fact or documentary evidence that can be relied on to satisfactorily establish a date of conception prior to 6/22/99. A satisfactory showing which relies upon supporting statements by witnesses might include a detailed declaration identifying the nature of the complete disclosure given to the respective declarant (i.e. oral, written, or otherwise), a description of what declarant understood of the complete disclosure at that time, and other pertinent circumstances surrounding the complete disclosure alleged (e.g. reasons indicating why the inventor was compelled to completely disclose the invention to the supporting witnesses, the nature of the inventive/business relationship between Declarant and each supporting witness, etc...). No strict requirements dictating the form and content of supporting evidence exists, however, any evidence offered will be looked on to satisfactorily support the allegations of the Declarant that conception of the invention was at least prior to 6/22/99.--MPEP 715.07.

The Affidavit alleges diligence, but does not explicitly allege diligence from a time just prior to 6/22/99 to filing of 11/16/1999.--MPEP 715.07(a).

The affidavit alleges diligence, but merely alleges two discrete points in time (i.e. 8/20/99 and 9/28/99) prior to 11/16/1999 in which activity is certain. Diligence is a showing of continuous activity or excusable inactivity from a time just prior to the effective date of the reference (i.e. 6/22/99) to a date of a reduction to practice of the invention, either actual or constructive. In the instant case, Declarant does not allege an actual reduction of practice prior to a constructive reduction to practice (i.e. the filing of the US patent application). Accordingly, a date of reduction to practice is considered to be 11/16/99-- the filing date of the US application. Declarant fails to account for hiatuses identified as follows: just prior to 6/22/99-just prior to 8/20/99; just after 8/20/99-just prior to 9/28/99; and just after 9/28/99-11/16/99. In patent law, an inventor is either diligent at a given time or is not diligent. An inventor may be diligent within the meaning of the patent law when he is excusably inactive. However, the record must set forth an explanation or excuse for the inactivity. The USPTO or courts will not speculate on possible explanations for delay or inactivity. In *re Nelson*, 420 F.2d 1079, 164 USPQ 458 (CCPA 1970). Diligence will be judged on the basis of the particular facts in each case.--MPEP 715.07(a).

The affidavit does not give clear a explanation of Appendices D and E pointing out exactly what facts are established and relied upon by Declarant. 505 F.2d at 718-19, 184 USPQ at 33. See also *In re Harry*, 333 F.2d 920, 142 USPQ 164 (CCPA 1964). For example, Declarant does not specifically point out where support for claim language is located in the respective Appendices--MPEP 715.07.